

P.O. Box 747
Falls Church, Virginia 22040-0747
Phone: (703) 205-8000
Fax: (703) 205-8050
(703) 698-8590 (GIV)

Birch, Stewart, Kolasch & Birch, LLP

Fax

To: Board of Patent Appeals and
Interferences

From: Elliot Goldberg

BPAI Hearings

Fax: 703-308-6199

Date: February 11, 2003

Phone:

Pages: 10 (including cover sheet)

Your Ref.: 08/841,318

Our Ref.: 1259-0181P

Re:

CC:

☒ **Urgent** ☐ **For Review** ☐ **Please Comment** ☐ **Please Reply** ☐ **Please Recycle**

This transmission is intended for the sole use of the individual and entity to whom it is addressed, and may contain information that is privileged, confidential, and exempt from disclosure under applicable law. You are hereby notified that any dissemination, distribution, or duplication of this transmission by someone other than the intended addressee or its designated agent is strictly prohibited. If your receipt of this transmission is in error, please notify this firm immediately by collect call to (703) 205-8000, and send the original transmission to us by return mail at the address above.

Comments: Hearing scheduled for Thursday, February 20, 2003 at
1:00 pm.

PATENT
1259-0191P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of Before the Board of Appeals

Kouki HATAKEYAMA

Appeal No.: 2002-0610

Application No.: 08/841,318

Group: 2612

Filed: April 30, 1997

Examiner: A. Harrington

For:

A METHOD OF CONTROLLING THE DISPLAY
MODE AND THE RECORDING MODE OF AN
ELECTRONIC STILL CAMERA (As Amended)CITATION OF NEW AUTHORITY UNDER THE PROVISIONS OF 1.192(a)Assistant Commissioner for Patents
Washington, DC 20231
Sir:

February 11, 2003

DISCUSSION

In the rejection of claim 7 on page 8 of the Examiner's Answer, it was stated as follows:

Although not specifically disclosed by Iura, it would have been matter of common sense, that a storage time calculated/determined . . . (Emphasis added).

In the case of *In re Zurko*, 59 USPQ 2nd, 1693, 1697 (Fed. Cir. 01), the Court stated as follows:

This assessment of basic knowledge and common sense was not based on any evidence in the record, and, therefore lacked substantial evidence support. (Emphasis added).

Application No. 08/841,318

Therefore, *In re Zurko*, (cited above), is further evidence that the rejection based on "common sense" is not valid.

In presenting the above authority, this is in addition to the traverse of the rejection of claim 7, which is of record and is maintained.

REASON FOR PRESENTING AUTHORITY

The *In re Zurko* case was not argued in the Brief or the Reply Brief, because the case was decided on August 2, 2001, which was after the Reply Brief filed on May 29, 2001.

It is therefore submitted that the *In re Zurko* case should be considered, because it was not available until after the Reply Brief was filed. It is submitted that this explanation meets the requirement of "good cause", as set forth in 37 C.F.R. 1.92(a), last sentence.

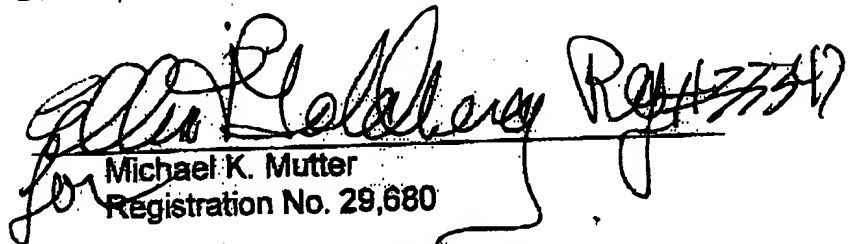
Application No. 08/841,318

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


 Michael K. Mutter
Registration No. 29,680

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

MKM/EAG/kss

1259-0191P